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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/22/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/374,408

Applicant(s)

ANDREWS, CHRISTOPHER C.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 23.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Interview Summary

Application No.

09/374,408

Applicant(s)ANDREWS, CHRISTOPHER
C.**Examiner**

Roland G. Foster

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All participants (applicant, applicant's representative, PTO personnel):

(1) Roland G. Foster.

(3)_____.

(2) Jonathon Owens (Reg. No. 37,902).

(4)_____.

Date of Interview: 29 July 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1-48.

Identification of prior art discussed: Bobo (U.S. Patent No. 5,675,507) and Uppaluru (U.S. Patent No. 5,915,001).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's representative and examiner discussed general issues regarding how the above identified prior art references read on the instant claims and discussed potential amendments. No agreement was reached.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection based substantially on new prior art discovered during an updated search.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "independently accessible address", "separately and directly accessible", and "unique to the recorded audio file."

Claim Rejections Using Choksi as a Base Reference

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 12-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,243 B1 to Choksi et al. ("Choksi"), newly cited.

With respect to claim 1, the following paragraphs for additional details on how Choksi discloses particular limitations in the claim.

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The limitation "a. establishing a telephony connection between a telephony device and a...[fax] recording device" reads on Figs. 1 and 6 where the transmitting fax 12 establishes a telephony connection via PSTN 16 in order to establish a connection with computer 18 (fax recording device). See also col. 5, lines 5-12.

The limitation "b. recording...[a fax] communication transmitted over the telephony connection thereby establishing a recorded...[fax] file" reads on Fig. 6, steps 106 and 108 where the transmitted fax is received and stored on computer 18.

The limitation "c. associating an independently accessible address with the recorded...[fax] file, such that when the address is accessed using the computer system, the recorded...[fax] file is transmitted to the computer system for playback" reads on Choksi as follows. Upon receipt of the fax, an e-mail including the URL of a web page at which the stored fax message may be sent to the user (col. 8, lines 49-56). The user then may access the fax message by visiting the web page associated with the URL within the e-mail (col. 8, lines 56-67)

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which is consistent with the applicant's specification.¹ The phrase "independently accessible address" is extremely broad. For example, the URL (address) associated with the recorded fax file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded...[fax] file is separately and directly accessible using the independently accessible address" reads on Fig. 1 where the recorded fax is stored at a URL (as discussed above) accessible via the Internet 22 at virtually any location in the world. An URL (address) that is accessible via the Internet at virtually any location in the world can be considered a separately and independently accessible address. For example, an "independent" computer 24 is capable of "separately" "accessing" the recorded fax file somewhere else on the Internet. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the URL within the e-mail which is consistent with the applicant's specification as discussed above.²

¹ This interpretation is consistent with the applicant's specification, which states that an e-mail containing the address of the message is sent to the user (page 8, lines 17-22, and page 13, lines 8-10).

² Note that the applicant's specification fails to provide antecedent basis for the terms "separately and directly accessible", "independently accessible address", and "unique to the recorded file" as discussed above. Nonetheless,

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The limitation "wherein the independently accessible address is unique to the recorded...[fax] file" reads on col. 7, line 65 - col. 8, line 2, col. 8, lines 53-55, and col. 10, lines 23-28 where the address "specifies" the location (web page) of the fax file via a URL address within a remote e-mail message. Therefore, the address is unique to the file otherwise it would not be able to specify (i.e., specific to) the location of the fax file via a remote e-mail.

Although Choksi discloses the processing of a recorded fax in the main embodiment as discussed above, Choksi fails to disclose in the main embodiment the recorded audio files are processed in the same manner. However, Choksi teaches in another embodiment that, in addition to processing fax files as discussed above, the system also processes voice messages (recorded audio files) (col. 9, lines 30-45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

examiner's interpretation is reasonably broad consistent with the applicant's specification.

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add the second embodiment supporting recorded audio files as taught by Choksi to the first embodiment disclosed by Choksi.

The suggestion/motivation for doing so would have been that Choksi teaches that the "present invention should in no way be limited" to the main embodiment but instead additionally support recorded audio files (col. 9, lines 30-45). In addition, it would have been facially obvious to one of ordinary skill in the art, upon inspecting single patent containing two embodiments, to have incorporated compatible features from one embodiment into the other embodiment because both embodiments are disclosed in the same document to the person of ordinary skill.

Claim 12 differs substantively from claim 1 in the following addition limitation "notification is sent to a recording user responsible for recording the audio communication, the notification specifying..." which reads on the transmittal of the e-mail containing the URL to the recording user as discussed in the claim 1 rejection above.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file

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is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on the transmittal of e-mail message (second file) which includes the file (col. 8, lines 40-58) modified to include the audio file (see the claim 1 rejection).

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, telephone 29. The limitation "b. means for recording..." and "c. means for storing..." reads on Fig. 1, computer 18.

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. See also Figs. 1 and 5 which illustrate the various circuits and systems to perform the functions recited in the claim. See the claim 22 rejection for further details.

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Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 5, fax message 44 and "b. a server coupled to the call processing and recording system" reads on Fig. 5, e-mail notification server 50. The limitation "c. one or more computer systems" reads on Figs. 1 and 5. Note that the above components have been modified to support recorded audio files (see the claim 1 rejection).

With respect to claim 44-47, see the claims 1, 22, 30, and 37 rejections respectively plus the claim 12 rejection for further details.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more users who uses the URL to received the recorded audio file.

With respect to claims 2 and 18, see Fig. 5.

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With respect to claims 3, 8, and 20, see col. 8, lines 60-67. Entry of a PIN would require a user profile to recognize the PIN.

With respect to claims 4, 5, 9, 13, 33, and 42, see the claims 1 and 37 rejections for further details.

With respect to claims 6, 29, 36, and 43, although Choksi discloses sending the URL in the e-mail as discussed above, Choksi fails to disclose that the e-mail is in the form of a hyperlink.

However, "Official Notice" is taken that both the concept and advantages of including hyperlinks in e-mail would have been well-known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a hyperlink to the e-mail comprising the URL as disclosed by Choksi.

The suggestion/motivation for doing so would have been to integrate the e-mail system with browsing capability and thus

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increase user-friendliness, efficiency and flexibility so that the user can directly launch a browser for the address corresponding to a particular URL address (i.e., eliminate browser launching and address selection steps) by simply clicking on a hyperlink within the e-mail as is notoriously well-known in the art.

With respect to claims 7, 18, 19, 23-28, 32, 34, 35, and 39-41, see Fig. 1.

With respect to claim 14, the link (URL) is posted in the e-mail (predetermined location).

With respect to claim 15, see col. 8, lines 60-67.

With respect to claim 16, although Choksi discloses that the user is provided descriptive information regarding the message (col. 8, lines 49-67), Choksi fails to specifically disclose that this information include the title.

However, "Official Notice is taken that both the concept and advantages of including the "title" in descriptive

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information about a file would have been well-known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add "title" to the descriptive file information disclosed by Choksi.

The suggestion/motivation for doing so would have been to quickly convey salient and easily remembered information about the file such as title as is notoriously well-known in the art.

With respect to claim 21, see the claim 12 rejection above.

With respect to claims 31 and 38, see Fig. 5, archive 48.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choksi as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 5,809,512 to Kato ("Kato"), newly cited.

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Choksi fails to disclose that the user or a location profile specifies a time where the recorded file is available for playback after a delay period.

However, Kato (similarly to Choksi) teaches of a multimedia message storage system (abstract) where the user specifies a delay period for posting (available for playback) using a stored, predetermined schedule (location profile) or manually (col. 75, lines 13-25, col. 76, lines 7-52, and col. 77, lines 1-5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability for the user to specify a delay using location profile or manually as taught by the message storage system of Kato to the message storage system of Choksi.

The suggestion/motivation with respect to a location profile would have been to increase the flexibility, versatility and efficiency and to reduce the cost of the message storage system by allowing the user to individually determine time periods in accordance with utilization conditions, CPU performance capabilities, and cost (Kato, col. 76, lines 18-52).

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In addition, flexibility would have been increased by allowing the user to determine posting time such as when the user has an urgent need to post the message immediately.

Claim Rejections Using Bobo as a Base Reference

Claim Rejections - 35 USC § 103

Claims 1-7, 9, 13-19, 22-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,675,507 to Bobo, II ("Bobo"), of record, in view of U.S. Patent No. 6,408,296 B1 to Acharya et al. ("Acharya"), newly cited.

With respect to claim 1, the following paragraphs for additional details on how Bobo discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on Figs. 1 and 2, where a telephone call (telephony connection) is established between Telephone Set 26 (telephony device) and a call recording device (Message Storage and Delivery System) (MSDS 10).

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The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on Fig. 2, step 52 where the voice message is recorded and stored.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Bobo as follows. The user accesses the voice message (recorded audio file) on the computer system by selecting the anchor (col. 13, lines 5-33). The anchor (hyper-text link) points to address where the file (e.g., voice message) is stored (e.g., <A HREF=1.wav") (col. 8, lines 8-20, col. 12, lines 30-54, and col. 13, lines 1-33). Therefore, the address is accessed using the computer system when the user selects the anchor (hypertext link) which points to the address of the recorded file consistent with the applicant's specification.³ The phrase "independently accessible address" is extremely broad. For example, the URL (address) associated with the recorded audio

³ This interpretation is consistent with the applicant's specification, which states that the user accesses the address where the recorded file is stored

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file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible using the independently accessible address" reads on col. 18, lines 35-56 where the recorded audio file is accessible via the WWW at "virtually any location in the world". An URL (address) that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, an "independent" computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) consistent with the applicant's specification as discussed above.⁴

Although Bobo discloses that the address is independently accessible as discussed above, Bobo fails to specifically disclose that the address is "unique to the recorded audio file."

by "selecting a hyperlink pointing to the address" (page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14).

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However, Bobo teaches that the hyperlink points to as address as discussed above. The address represents the location of the file on a computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out the full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Bobo strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address) (col. 1, lines 35-47). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

⁴ See footnote 2.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Acharya to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been to increase the efficiency and reliability of recorded file retrieval. Specifically, if the hyperlink did not point to an address unique to the recorded file, then the system of Bobo would have had difficulties reliably locating and retrieving the recorded file. Further, the prior art recognizes that it is "traditional" for a hyperlink to point an address unique to a file (Acharya, col. 1, lines 44-50). Finally, Bobo provides the capability (no structural modification required) for the user to specify the content of the hyperlink to reflect the full path (address) unique to the recorded file as discussed above. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In this way, owners of the patented prior art devices are protected when using their devices as they see fit. Here, the content of the prior art hyperlink structure of Bobo is able to perform the intended use of identifying a unique address for the file as discussed above. Therefore, Bobo as modified meets the claim requirements.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Bobo as discussed above where the recorded file is included in a second file such as "1.wav" that is accessed via an html file containing the anchor (hyperlink) (first file).⁵ See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1.

⁵ Note that is interpretation is also consistent with the applicant's specification which also indicates that including the audio file within a second file such as a web page or e-mail may be accomplished by including a hypertext link (anchor) to a recorded file (Fig. 6, step 152 and page 16, lines 24-28).

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Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, Telephone Set 26. "[B]. Means for recording..." and "c. means for storing..." reads on Fig. 1, MSDS (10).

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 13, Central Processor (3) and "b. a server coupled to the call processing and recording system" reads on Fig. 13, Internet Server 5. Note that Fig. 13 illustrates the various systems that comprise MSDS 10. See also col. 16, lines 47 - 67. The limitation "c. one or more computer systems" reads on Fig. 1, Computer 32.

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Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more use who logs into the mailbox with the appropriate ID and password.

With respect to claim 2, see Fig. 13, Internet Server 5 and col. 17, lines 37-43.

With respect to claim 3, see Fig. 8 and col. 12, line 63 - col. 13, line 23. Note that the address (URL) is accessed when the audio file is retrieved.

With respect to claims 4, 28, and 42, see col. 13, lines 10-15 where the user selects an anchor (hyperlink) to access a voice message (audio file). Although the anchor (hyperlink) may be a simple HREF command referring to the voice message (audio file), selecting the hyperlink would still result in the html address (URL) corresponding to user's mailbox on the Internet Server 5 being sent to Internet Server 5 in order for the browser to request and retrieve the voice message (audio file) from Internet Server 5.

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With respect to claims 5, 25, 26, 33, and 34, see Fig. 1 where an Internet (data) connection is established between the Computer 32 and the MSDS 10 in order to play back recorded audio (col. 12, line 63 - col. 13, line 33).

With respect to claims 6, 29, 36, and 43, see col. 13, lines 10-15 and the claim 4 rejection above.

With respect to claims 7, 24, 32, and 39, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claim 9, the message storage process of Fig. 2 and message retrieval process of Fig. 3 are separated by time. The phrase "recorded audio file is first available for playback" is a broad term. For example, an audio file may be only considered "available" to the user when the user has established an Internet connection and successfully logged onto the MSDS 10 by entering a correct logon id and password. If the user is unable to log onto the MSDS 10, then the audio files are "unavailable" to the user.

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With respect to claim 13, see col. 8, lines 10-20 and col. 13, lines 16-18.

With respect to claim 14, the link is posted in a predetermined location, namely in the MSDS 10.

With respect to claim 15, see col. 13, lines 13-14.

With respect to claim 16, see Table 1 (col. 12, lines 30-53).

With respect to claim 18, the web server would serve the html file and anchored audio file (step of including is performed by a server).

With respect to claim 19, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claims 23, 31, and 38, see Fig. 15, Storage (11).

With respect to claim 27, see Fig. 13, Internet Server (5).

With respect to claim 35, see Fig. 15, Storage (11) where the html files are addressed via the Internet (30).

With respect to claim 40, see col. 6, lines 20-22.

With respect to claim 41, see Fig. 1.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo in view of Achayra as applied to claims 1 and 9 above, and further in view of Kato.

Bobo fails to disclose the limitations within claims 10 and 11 however this would have been an obvious addition as taught by Kato. See the Choksi in view of Kato rejection above for further details regarding the obviousness of adding the teachings of Kato.

Claim Rejections Using Uppaluru as a Base Reference

Claim Rejections - 35 USC § 102

Claims 1, 8, 17, 20, 22, 30, 37, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO.

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5,915,001 to Uppaluru ("Uppaluru"), of record, in view of Acharya.

Uppaluru teaches of a system for providing speech files that are accessible via the Internet. Significantly, Uppaluru also teaches of allowing users to make the speech files accessible (publishing the speech files) using a telephonic connection.

With respect to claim 1, the following paragraphs for additional details on how Uppaluru discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on col. 20, lines 4-10.

The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on col. 21, lines 10-13.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address

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is accessed using the computer system, the recorded audio filed is transmitted to the computer system for playback" reads on Uppaluru as follows. A URL (address) is associated with the recorded audio files (col. 21, lines 25-29 and col. 7, lines 13-67). The URL can then be accessed telephonically (col. 7, lines 28-39) or via a WWW browser (col. 7, lines 20-21) via hyperlinks (abstract). The hypertext link points to address where the file (e.g., voice message) is stored (e.g., <A HREF="myweb/home/prompts.vml#prompt1") (Appendix A). Therefore, the address is accessed using the computer system when the user selects the hypertext link which points to the address of the recorded file.⁶ The phrase "independently accessible address" is extremely broad. For example, the URL address of Uppaluru associated with the recorded audio file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible using the independently accessible address" reads on Uppaluru as follows. The recorded audio file is accessible via the WWW using a conventional web browser (col. 7, lines 20-23) which means the file is accessible

⁶ See footnote 3.

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at virtually any location in the world. An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, an independent computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) (abstract) consistent with the applicant's specification as discussed above.⁷

Although Uppaluru discloses that the address is independently accessible as discussed above, Uppaluru fails to specifically disclose that the address is "unique to the recorded audio file."

However, Uppaluru teaches that the hyperlink points to as address which certainly appears unique to the file as discussed above. The address represents the location of the file on a computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out

⁷ See footnote 2.

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the full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Uppaluru strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address (col. 1, lines 35-47)). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Uppaluru to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been for the same reasons that Acharya was an obvious addition to Bobo.

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Therefore, see the claim 1, Bobo in view of Acharya rejection for further details.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Uppaluru as discussed above where the recorded file is included in a second file such as "prompt.vml" that is accessed via an html file containing the anchor (hyperlink) (first file).⁵ See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection" reads on Fig. 1, Telephone Set 111. The limitation "b. means for recording" reads on Fig. 1, Voice and Telephony Interface 114 and col. 6, lines 23-30. The limitation c. means for storing" reads on Fig. 1, Voice Web Site 102.

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Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. "a. a call processing and recording system..." reads on Fig. 1, Voice and Telephony Interface 114. "b. a server coupled to the call processing and recording system..." reads on Fig. 1, Voice Web Site 102.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Uppaluru where the message is played back to each of the one or more user who log onto the voice web system.

With respect to claim 8, see col. 1, lines 33-67.

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With respect to claim 20, see col. 1, lines 33-67.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.


Roland G. Foster
Patent Examiner
August 19, 2003